

Oral Hearing held:
May 23, 2006

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

*Decision mailed:
August 25, 2006
GDH/gdh*

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re JMH Productions, Inc.

Serial No. 76608812

Donald L. Dennison of Dennison, Schultz, Dougherty & Macdonald
for JMH Productions, Inc.

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(Chris Doninger, Managing Attorney).

Before Hohein, Bucher and Walsh, Administrative Trademark Judges.
Opinion by Hohein, Administrative Trademark Judge:

JMH Productions, Inc. has filed an application to register the mark "MISS NUDE CENTERFOLD SEARCH" on the Principal Register in standard character form for "pre-recorded videotapes, CD-ROMS, and DVDS featuring adult entertainment" in International Class 9 and "entertainment services, namely, a television series featuring adult entertainment" in International Class 41.¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that, when used in connection with applicant's goods and

¹ Ser. No. 76608812, filed on August 26, 2004, based upon an allegation of a bona fide intention to use such mark in commerce.

services, the mark "MISS NUDE CENTERFOLD SEARCH" is merely descriptive of them.

Applicant has appealed. Briefs have been filed and an oral hearing was held. We reverse the refusal to register.

It is well settled that a mark is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a mark describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the mark describes a significant attribute or idea about them. Moreover, whether a mark is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services and the possible significance that the mark would have to the average purchaser of the goods or services because of the manner of such use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is

not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., In re Abcor Development Corp., supra at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., In re Atavio, 25 USPQ2d 1361 (TTAB 1992) and In re TMS Corp. of the Americas, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

Applicant, noting in its brief the Examining Attorney's reliance upon (i) dictionary definitions, which she made of record, of the individual words comprising its mark to support her argument that the mark is merely descriptive of the subject matter and purpose of, respectively, applicant's goods and services because "the goods feature the search for a nude female centerfold" while the services involve "a search for Miss Nude Centerfold" and (ii) excerpts, which she also made of record, of articles and webpages from a search of the Internet for the

purpose of showing that "the wording in the proposed mark is commonly used in connection with services of the type identified in this application," asserts that (footnote omitted; bold in original):²

In its response to the Final Refusal, Applicant made of record thirty-one separate registration[s] or allowed applications of marks owned by third parties that included the wording "MISS (or MS.) NUDE" combined with other words, generally geographic or place names.

These citations were submitted to show the recognition by the USPTO that marks such as **MISS NUDE KENTUCKY** (with a disclaimer of "nude and Kentucky") are registrable.

The Examining Attorney's actions in this case are clearly opposite to the well established history of Miss Nude marks in the USPTO by a large number of Examining Attorneys.

Applicant, in light thereof, further argues that "[t]he position taken by this Examining Attorney is clearly inconsistent with the prior and present practice before this Office in connection with similar trade marks" inasmuch as "[t]he sheer number of third[-]party registrations of record here containing 'MISS NUDE ...' demonstrates that consumers and the general public view these marks as an indication of origin of goods and

² The Examining Attorney, citing Trademark Rule 2.142(d), has objected in her brief to applicant's reference in its brief to what it asserts are its pending applications for the marks "MS NUDE CARNIVAL RIO" and "MS NUDE CARNIVALE." Inasmuch as the Examining Attorney is correct that such applications "were not properly made of record by applicant prior to the appeal" since the mere mention thereto in a list or other reference thereto is insufficient to make such applications part of record because the Board does not take judicial notice of applications which have been filed in the U.S. Patent and Trademark Office, the objection is sustained. No further consideration, therefore, will be given to applicant's claimed pending applications. See Trademark Rule 2.142(d) and, e.g., In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974).

pageants rather than as a descriptive phrase." Moreover, and in any event, applicant contends that "[a]s stated in *In re Calspan Tech. Prods., Inc.*[,] 197 USPQ 647 (TTAB 1977), a combination of words in a mark, each of which may be descriptive in their own right, may result in a mark which is not in fact descriptive." Any doubts concerning whether a mark is merely descriptive or, instead, is at a minimum suggestive "are to be resolved in favor of the Applicant during a *ex parte* prosecution," applicant insists, citing *In re LRC Products Ltd.*, 223 USPQ 1250, 1252 (TTAB 1984) and *In re Micro Instrument Corp.*, 222 USPQ 252, 255 (TTAB 1984).³

The Examining Attorney, on the other hand, asserts that the mark "MISS NUDE CENTERFOLD SEARCH" "is merely descriptive of the subject matter and purpose of the identified goods and services" based upon "evidence consisting of dictionary definitions and Internet evidence showing use of the wording by third parties for similar goods/services." In particular, she notes that the record contains the following definitions from The American Heritage Dictionary of the English Language (3rd ed. 1992) of the words which comprise applicant's mark:

"miss," which is defined as a noun meaning "1. **Miss.** Used as a courtesy title before the surname or full name of a girl or single woman. 2. Used as a form of polite address for a girl or young woman: *I beg your pardon, miss.* 3. A young unmarried woman. 4. **Miss.** Used as a prefix to the

³ See also *In re Conductive Systems, Inc.*, 220 USPQ 84, 86 (TTAB 1983); *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

name of that which a usually young woman is held to represent: *She's Miss Personality.*";

"**nude**," which is listed as an adjective meaning "1. Being without clothing; naked.";

"**centerfold**," which is set forth as a noun connoting "1. A magazine center spread, especially a foldout of an oversize photograph or feature. 2. a. The subject of a photograph used as a centerfold, often a nude model. b. A feature, such as an advertisement or calendar, inserted as a centerfold."; and

"**search**," which is defined as a noun as signifying "1. An act of searching."

She further notes that "[a]dditional dictionary evidence from www.inforplease.com ... indicates that the term 'search' is also defined as [a verb to mean] 'to uncover or find by exploration or examination[:] to search out all the facts'" and, we observe, is similarly defined as meaning "to explore or examine in order to discover. *They searched the hills for gold.*"

In consequence of the above definitions, the Examining Attorney maintains that she has not improperly dissected applicant's mark. Rather, citing *In re Tower Tech Inc.*, 64 USPQ2d 1314, (TTAB 2002), she insists that while applicant is correct that "[a] mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning," it is also the case, however, that "if each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive." She thus contends that:

In this case, the composite mark immediately conveys a great deal of information to consumers about the

applicant's goods and services. The information conveyed is that MISS NUDE CENTERFOLD SEARCH (i.e. a hunt for a woman or women to pose naked for centerfold pictures) is the exact subject matter of the pre-recorded videotapes, CD-ROMS, and DVDS featuring adult entertainment and the subject matter and purpose of the entertainment services, namely a television series featuring adult entertainment. The Board has previously found that a proposed mark that describes the subject matter of a television program is merely descriptive of the program. *In re Weather Channel, Inc.* 229 USPQ 854 (TTAB 1986). In the *Weather Channel* case, the Board held WEATHER CHANNEL ... merely descriptive of a television program.

In addition, the Examining argues that "the Internet evidence of record indicates that consumers would associate the proposed mark with the subject matter and purpose of the goods and services rather than with the source of the goods and services." Such evidence, the Examining Attorney maintains, "indicates that the wording 'Miss Nude' and 'Centerfold Search' is commonly used in connection with adult entertainment." In particular, the Examining Attorney points to "the following examples of use of the wording in the proposed mark in applicant's industry:" (i) "evidence from www.realitytvlinks.com stating 'Playboy Centerfold Search--search the net for centerfold content'"; (ii) "evidence from www.pageant.com entitled 'A Modest Peak At An Immodest Pageant' and stating, 'The Miss Nude Georgia Pageant is held in Atlanta, the city that is famous for its 'girlie' nightclubs and unclothed exhibitions'"; (iii) "evidence from www.esweepstakes.com simply advertising a 'Miss Nude Contest'"; and (iv) "evidence from www.hooziera.com entitled 'Roselawn Hosts Annual Nudes-A-Poppin Festival' and

stating that 'the festival celebrates the nudist lifestyle and features several contests [which] include the Miss Nude Galaxy Club Beauty Pageant, Mr. Nude Galaxy, Miss Nude Showstopper, Miss Nude Rising Star and Mr. Nude Go-Go.'

Also, while not mentioned in her brief, the Examining Attorney made of record evidence from the desmoinesregister.com website, consisting of an article headlined "The naked truth: D.M. to host Miss Nude World competition," which states in relevant part that:

Des Moines lost the state FFA convention this year, but the city has grabbed the Miss Nude World pageant--landing the contest that had been held in Atlanta and Miami in recent years.

....
The pageant's home will be the Lumber Yard, a strip club located just north of the Des Moines city limits not far from U.S. Highway 69.

The Lumber Yard has been developing a national reputation among aficionados of the birthday-suit form of entertainment, and the Miss Nude World pageant is expected to boost that reputation.

....
To be eligible for the Miss Nude World pageant, contestants must have won a previous nude beauty contest Competitors will include the winner and runner-up from the first Miss Nude Iowa contest, which was held at the Lumber Yard earlier this month.

....
The Miss Nude World pageant has been featured in recent years on the Ricki Lake talk show and the HBO program "Real Sex" A Florida Company, Fine Grove Films and No Strings Attached Films, is a major national sponsor of the world contest The company films the contests and later sells copies.

Likewise, while not referred to in her brief, she additionally made of record several stories from the "NEXIS" database to show

that, as indicated in the final refusal, "the wording 'centerfold search' is commonly used to describe contests and searches for centerfold models" and "the wording 'Miss Nude' is commonly used to identify contests [which] search for a contestant to be named Miss Nude." For example, a story in the St. Louis Post-Dispatch refers to "P.T.'s Showclub executive director Jamil Akman, back in our town after opening a club in Las Vegas, is putting on another Akman classic production, 'The Future Centerfold Search,' to be held each Wednesday in November at the Sauget-based strip club," while a story from the Salon.com website mentions that "dancers are advised to enter as many beauty pageants as possible, especially those whose names begin with the words 'Miss Nude.'" In view thereof, the Examining Attorney insists that "[s]ince MISS NUDE and CENTERFOLD SEARCH have been clearly shown to be widely used within the adult entertainment industry, there is a clear competitive need for these terms" and that "there is no doubt that the proposed mark is merely descriptive of the goods and services in this case" (*italics in original*).

As to applicant's reliance on third-party registrations to support its contentions that its mark is suggestive and that the Examining Attorney has acted inconsistently herein because the USPTO has previously allowed registration of similar marks on the Principal Register, the Examining Attorney insists that:

The examining attorney does not dispute that the Office has previously registered other marks featuring the wording MISS NUDE on the Principal Register for similar services and owned by third parties. However, the examining attorney respectfully submits that third-party registrations are not conclusive on the question of [mere]

descriptiveness. Each case must be considered on its own merits. A proposed mark that is merely descriptive does not become registrable simply because other similar marks appear on the register. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977); TMEP §1209.03(a). In that case, the Board held SCHOLASTIC ... merely descriptive of devising, scoring and validating tests for others although applicant's evidence included third[-]party registrations comprising or including SCHOLASTIC for various products. In addressing this issue, the Board stated, "[i]n a final analysis, we are not so much concerned with what has been registered, but rather what should or should not be registered. *Scholastic Testing*, at 519.

With respect to the evidentiary value of third-party registrations, the Board in the recent case of *In re First Draft Inc.*, 76 USPQ2d 1183, 1187 (TTAB 2005), noted that "[t]here can be no doubt that 'the Board ... must assess each mark on the record of public perception submitted with the application,'" quoting from *In re Nett Designs Inc.*, 236 F.3d 1139, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).⁴ As set forth in the latter case, our principal reviewing court observed that "[t]he perception of the relevant purchasing public sets the standard for determining

⁴ *Nett Designs* affirmed the Board's finding that the term "ULTIMATE," as used in the mark "LOAD LLAMA THE ULTIMATE BIKE RACK" and design which was sought to be registered on the Principal Register for, *inter alia*, "carrying racks for mounting on bicycles," was merely descriptive thereof and hence was properly required to be disclaimed. The court, on the basis of dictionary definitions and advertising literature for such goods, held that "substantial evidence supports the Board's finding that consumers will immediately regard THE ULTIMATE BIKE RACK as a laudatory descriptive phrase that touts the superiority of Nett Designs' bike racks" and that, while "[t]he record in this case contains many prior registrations of marks including the term ULTIMATE," "[t]hese prior registrations do not conclusively rebut the Board's finding that ULTIMATE is descriptive in the context of this mark." *In re Nett Designs Inc.*, 236 F.3d 1139, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

descriptiveness," citing *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986), while adding that:

In the complex world of etymology, connotation, syntax, and meaning, a term may possess elements of suggestiveness and descriptiveness at the same time. No clean boundaries separate these legal categories. Rather, a term may slide along the continuum between suggestiveness and descriptiveness depending on usage, context, and other factors that affect the relevant public's perception of the term.

Nett Designs, supra at 57 USPQ2d 1566. Although ultimately concluding, in view thereof, that "[t]he Board must decide each case on its own merits" and that, as to the evidentiary value of third-party registrations, "[e]ven if some prior registrations had some characteristics similar to [applicant's] application, the ... allowance of such prior registrations does not bind the Board or this court," the court added that, "[n]eedless to say, this court encourages the [US]PTO to achieve a uniform standard for assessing registrability of marks." Id. Therefore, even though the submission of copies of third-party registrations may not be said to establish a binding USPTO practice, it remains the case that such registrations may in general be given some weight to show the meaning of a mark in the same way that dictionary definitions would be so used. See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976).

When the third-party registrations made of record herein are so viewed, along with the dictionary definitions, "NEXIS" stories and Internet evidence offered by the Examining Attorney, we agree with the Examining Attorney to the extent that, in the context of applicant's "pre-recorded videotapes, CD-

ROMS, and DVDS featuring adult entertainment" and its "entertainment services, namely, a television series featuring adult entertainment," the terms "NUDE," "CENTERFOLD" and "SEARCH" are indeed merely descriptive of the subject matter of such goods and services. Moreover, when combined to form the phrase, "NUDE CENTERFOLD SEARCH," such terms readily retain their merely descriptive significance; no separate, nondescriptive meaning is created by the combination thereof, nor is there anything which is ambiguous, incongruous or suggestive. Rather, applicant's goods and services involve as their subject matter a search for a nude centerfold and such meaning is immediately conveyed, without the need for speculation, conjecture or the gathering of further information, to consumers by the words "NUDE CENTERFOLD SEARCH." Thus, while the Examining Attorney has not required, in the alternative, that applicant disclaim such words pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), in the context of adult entertainment, there is no doubt on this record that applicant has no exclusive right to the use of the words "NUDE" and "CENTERFOLD" nor, insofar as its goods and services feature as their subject matter the search for a nude centerfold, does it possess the exclusive right to use of the word "SEARCH."⁵

However, as to the word "MISS," we disagree with the Examining Attorney that the relevant consuming public would immediately regard such term as signifying only its literal

⁵ While applicant indicated a willingness at the oral hearing to at least disclaim the word "NUDE" and possibly the word "CENTERFOLD," any disclaimer should be submitted prior to publication of its mark in the Official Gazette. For the proper format of a disclaimer, attention is directed to TMEP Sections 1213.08(a) and (b) (4th ed. 2005).

meaning of a young unmarried woman, notwithstanding the bare fact that in today's popular culture, it is common knowledge that nude centerfold models, especially those whose natural or enhanced talent and ability have garnered them public recognition as a "Miss Of The Month" or other perhaps coveted title, are overwhelmingly young unmarried women. Instead, as the third-party registrations submitted by applicant, as well as the Examining Attorney's own evidence, make clear, the term "MISS" is used in its dictionary sense of "a prefix to the name of that which a usually young woman is held to represent."⁶ As so used, such term would be perceived by consumers, however, as a courtesy title or form of polite address for a young woman selected as the winner or representative of a beauty contest, featured periodical pictorial, or other media layout or display, but it does not merely describe such designations or categories with any degree of particularity nor constitute its own subject matter. That is,

⁶ Of the 28 third-party registrations relied upon by applicant, 18 are owned by the same registrant; the other ten are owned by nine different registrants; and all involve entertainment services in the nature of beauty pageants or beauty contests. Although, for the first time at oral argument, the Examining Attorney argued that the third-party registrations were not relevant because the services recited in such registrations are different from the goods and services for which applicant seeks registration, we fail to see any meaningful difference between conducting a beauty pageant or contest and either (i) producing a television series featuring a beauty pageant or contest or (ii) selling pre-recorded videotapes, CD-ROMS and DVDs featuring such entertainment. The third-party registrations are therefore relevant and the Examining Attorney has offered no examples to the contrary in which, for instance, the word "MISS" is disclaimed when forming part of a mark registered on the Principal Register or a mark incorporating such word is registered on the Supplemental Register. Moreover, while applicant has additionally relied upon three third-party applications which it asserts have been "allowed," such applications are proof of nothing more than that they were filed and thus are without probative value. See *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467, 468 (TTAB 1973) at n. 3.

while concededly a subtle point, use of the term "MISS" is essentially a legal fiction in that it is not regarded by the relevant purchasing public in a strictly dictionary sense of a young unmarried woman but, rather, is understood as simply suggestive of an honorary title or name given to the young woman selected as a winner or representative of a particular event or activity. Consequently, when the term "MISS" is combined with the descriptive wording "NUDE CENTERFOLD SEARCH," the resulting mark as a whole is not merely descriptive of the adult entertainment subject matter of applicant's goods and services, but is only suggestive thereof.

Stated otherwise, while "NUDE CENTERFOLD SEARCH" is indeed merely descriptive of the specific theme of applicant's "pre-recorded videotapes, CD-ROMS, and DVDS featuring adult entertainment" and its "entertainment services, namely, a television series featuring adult entertainment," the addition of the title or form of address "MISS" to form the mark "MISS NUDE CENTERFOLD SEARCH" is suggestive of such goods and services inasmuch as it would be regarded by consumers as the title conveyed upon the prevailing "contestant" in an adult beauty pageant contest or search to find a nude centerfold. In garnering such a perception, consumers would need to employ just enough of a multi-stage reasoning process, or utilize at least a minimum amount of imagination or thought, in order to determine the particular subject matter of applicant's goods and services. The mark "MISS NUDE CENTERFOLD SEARCH" is therefore suggestive

rather than merely descriptive of such adult-themed goods and services.

Finally, because the plethora of third-party registrations submitted by applicant serve at the very least to raise some doubt that the relevant consuming public would regard applicant's "MISS NUDE CENTERFOLD SEARCH" mark in its entirety as immediately conveying the subject matter of its goods and services, we resolve such doubt, in accordance with the Board's settled practice, in favor of the publication of applicant's mark for opposition.

Decision: The refusal under Section 2(e)(1) is reversed.